UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,236	04/24/2000	Alan Edward Kaplan	Kaplan 111711	8648

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EXAMINER
ZAND, KAMBIZ

ART UNIT	PAPER NUMBER
2132	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/558,236	Applicant(s) KAPLAN, ALAN EDWARD	
	Examiner Kambiz Zand	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _24 April 2000_.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-17_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-17_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _24 April 2000_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _2_ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

1.   The numbering of claims is not in accordance with 37 CFR 1.126 which requires

the original numbering of the claims to be preserved throughout the prosecution. When

claims are canceled, the remaining claims must not be renumbered. When new claims

are presented, they must be numbered consecutively beginning with the number next

following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 10-18 have been renumbered as claims 9-17.

2.   **Claims 1-17** have been examined.

Information Disclosure Statement PTO-1449

3.   The pages of the all references submitted by applicant have been considered.

Drawings

4.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they include the following reference sign(s) not mentioned in the description:

"??" in fig. 1. Correction is required.

Claim Objections

5.   Claim 8 is objected to because of the following informalities: Typo errors.

Examiner considers characters (d), (e) and (f) in the claim as a typo errors. Examiner

suggests characters (a), (b) and (c) as a correct representation of the steps in the claim.

Appropriate correction or clarification is requested.

Claim Rejections - 35 USC § 101

6.   **Claims 9-14** are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. A markup language is a storage having

disembodied data structure table involving no more than descriptive characters (see

specification, page 6, lines 9-10) and therefore, is nonstatutory under 35 U.S.C. 101.

See In re Warmerdam, 33 F.3d 1354; 31 USPQ2d 1754. See MPEP § 2106 IV. B. 1.

See http://www.uspto.gov/web/menu/pbmethod/ (35 U.S.C. 101 Training Materials).

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
subject matter, which the applicant regards as his invention.

8.   **Claims 8 and 16-17** are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

In claims 16-17, the "for magnifying" and "for narrowing field of view" phrases

respectively makes the claims indefinite and unclear in that neither means nor

interrelationship of means are set forth in these claims in order to achieve the desired

results expressed in the "for magnifying" and "for narrowing field of view" phrases.

9.   **Claim 8** recites the limitation "said challenges" in the claim. There is insufficient

antecedent basis for this limitation in the claim.

Double Patenting

10.   **Claim 2** is objected to under 37 CFR 1.75 as being a **substantial duplicate of**

claim 1. When two claims in an application are duplicates or else are so close in

content that they both cover the same thing, despite a slight difference in wording, it is

proper after allowing one claim to object to the other as being a substantial duplicate of

the allowed claim. Claim 2 recite said first step is taken before said second step and

said third step succeeds said first step and said second step (the method steps are in

chronological method steps of 1, 2 and 3. Execution of contents of claim 1 also is being

done in three steps and in chronological steps 1, 2 and then step 3). See MPEP

§ 706.03(k).

Claim Rejections - 35 USC § 102

11.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) do not apply to the examination of this application as the application

being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

published under 35 U.S.C. 122(b). Therefore, this application is examined under 35

U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12.   **Claims 1-8** are rejected under 35 U.S.C. 102(e) as being anticipated by Owens

et al (6,338,140 B1).

As per claims 1 and 2 Owens et al (6,338,140 B1) teach a method executed by a

provider of authorizing provision of service to a user (see abstract where authorization

for placing of a call and its execution is being provided to a user by a service provider)

comprising: a first step of interacting with said user to receive an ID from said user (see

fig.9, item s100 where by powering a mobile telephone and interacting with it, a user id

such as ESN, MIN is being received) and with a database to receive an ordered list of

characters associated with said ID that were selected by said provider (see fig.9, item

s120 where a dynamic PIN is being generated and this the characters in a dynamic

format that is associated with the user ID since is being generated based on the

receiving of the ESN and MIN of the user mobile device and where having a memory;

col.7, lines 46-54 where a database mapping the identification to respective keys or

random characters); a second step of interacting with said user to receive from said

user information responsive to requests placed to said user in the course of said

interacting (see fig.9, item s140-s200 where the request for placing a call and

authentication of the user's random PIN according to the mapping database instruction

such as calling profile numbers (see abstract) of col.7, lines 46-54 is being processed);

and a third step of authorizing said provision of service when said information received

in response to said requests corresponds to a subset of entries in said ordered list of

characters that is associated with said requests placed to said user, provided that said

service is permitted service for a user who provides said ID (see fig.9, item s220 and

s240 where access to the service is granted). Also see abstract where dynamic PIN

generator create keys randomly in order to avoid cloning phones and stealing telephone

identities; col.7, lines 22-67; col.8-19 and col.20, lines 1-18 for more detailed description

of the above limitations.

As per claim 3 Owens et al (6,338,140 B1) teach all limitation of claim 1 where said

second step is taken before said first step (see col.9, lines 5-6 where the steps in claim

1 may be sequential, or independent steps and therefore the reversal of the steps 1 and

2 are allowed. Examiner suggests Applicant to specifically disclose the reversal steps

base on the support in the specification in the claim language in a manner to

distinguishes itself from the sequential and independent steps and routine branching

programs, a well known tool in the art of software programming.

As per claim 4 Owens et al (6,338,140 B1) teach the method of claims 1 and 9 where

said characters are taken from set {0-9, #, *} since it is the Examiner position that

having the set of {0-9, #, *} on a telephone' key pad is inherent part of the art of

telecommunication.

As per claim 5 Owens et al (6,338,140 B1) teach the method of claim 1 where said

second step comprises the steps of: generating a predetermined number of random

variables (see fig.9, item s120 where a dynamic PIN is being generated and this the

characters in a dynamic format that is associated with the user ID since is being

generated based on the receiving of the ESN and MIN of the user mobile device and

where having a memory; col.7, lines 46-54 where a database mapping the identification

to respective keys or random characters); for each random number created in said step

of generating (a) requesting said user to provide a responsive string of characters that is

related to said random number (see fig.9, item s140-s200 where the request for placing

a call and authentication of the user's random PIN according to the mapping database

instruction such as calling profile numbers (see abstract) of col.7, lines 46-54 is being

processed) , (b) receiving said responsive string of characters from said user, and (c)

flagging a number in said ordered list corresponding to said random number (see

abstract where a number in the profile numbers is flagged based on database mapping

instruction according to col.7, lines 46-54 and fig.9, s120 and s140 where the flag

number is being dialed or access to that number is being granted).

As per claim 6 Owens et al (6,338,140 B1) teach the method of claim 1 where said

requests are communicated over a telephone, and said responsive string of characters

is communicated over said telephone (see abstract; fig.2, 5 and 8 and fig.9, item s100-

s160 that clearly disclose that requests are over a telephone and the random characters

are transmitted over a telephone).

As per claim 7 Owens et al (6,338,140 B1) teach the method of claim 1 where said

service comprises telecommunication service (see fig.2,5 and 8; col.13, lines 7-34

where the telecommunication service provide services to the subscriber).

As per claim 8 Owens et al (6,338,140 B1) teach a method of authorizing provision of

service to a user comprising the step of: receiving a ID from said user (see fig.9, item

s100 where by powering a mobile telephone and interacting with it, a user id such as

ESN, MIN is being received); accessing a database to retrieve N ordered lists of

characters associated with said ID, where N is an integer; generating a predetermined

number of random variables (see fig.9, item s120 where a dynamic PIN is being

generated and this the characters in a dynamic format that is associated with the user

ID since is being generated based on the receiving of the ESN and MIN of the user

mobile device and where having a memory; col.7, lines 46-54 where a database

mapping the identification to respective keys or random characters that are integer

numbers such as 1, 2,..etc.); for each random number created in said step of generating

(d) requesting said user to provide a responsive string of characters that is related to

said random number (see fig.9, item s140-s200 where the request for placing a call and

authentication of the user's random PIN according to the mapping database instruction

such as calling profile numbers (see abstract) of col.7, lines 46-54 is being processed) ,

(e) receiving said responsive string of characters from said user, and (f) flagging a

number in said N ordered list corresponding to said random number; and authorizing

said provision of service when the set of responsive numbers received in response to a

challenges matches a corresponding set of flagged number in any of said N ordered

lists of numbers, provided that said service is a permitted service for a user who is

associated with the ordered list that matches (see abstract where a number in the

profile numbers is flagged based on database mapping instruction according to col.7,

lines 46-54 and fig.9, s120 and s140 where the flag number is being dialed or access to

that number is being granted).

Claim Rejections - 35 USC § 103

13.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14.   **Claims 9-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al (6,338,140 B1) in view of Applicant Admittance of Prior Art (AAPA).

As per claim 9 Owens et al (6,338,140 B1) teach a card characterized by a table of characters (see fig.10; col.62-67 and col.14, lines 1-5 where the token or calling card having a tables ID to MIN relation table and MIN to cryptographic key relation table in col.15-16) but do not disclose explicitly a calling card. However AAPA in page 1 of the specification admit that calling card is disclosed in prior art. It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize calling card of prior art in Owen's dynamic Pin generator and its database mapping system in order to have a preventing cloning or stealing the calling card's id as disclosed in Owen's abstract.

As per claim 10 Owens et al (6,338,140 B1) teach the calling card of claim 9 where said table has rows, one column contains a row numbers, and other columns contains a character string (see col.14, lines 48-56 where the table has rows, three of them; and it has a column that contains rows numbers. Examiner considers column 2, representing the three rows numbers 1, 3 and 8); and other columns that contains a characters (see other columns that has different characters in the table in col.14, lines 48-56).

As per claim 11 Owens et al (6,338,140 B1) teach the method of claims 1 and 9 where said characters are taken from set {0-9, #, *} since it is the Examiner position that having the set of {0-9, #, *} on a telephone' key pad is inherent part of the art of telecommunication.

As per claim 12 Owens et al (6,338,140 B1) teach the calling card of claim 9 where said table has rows and more than two columns, where one column contains a row numbers, and other columns contains other numbers (see col.14, lines 48-62 where the table clearly disclose column that represent numbers and characters and it has more than one row and more than one column).

As per claim 13 Owens et al (6,338,140 B1) teach the calling card of claim 9 further comprising an alphanumeric string (see abstract; fig.9, item s120 where the accessed number is alphanumeric string; col.16, lines 58-64 see the example *66 15 7 86 #202 555 1212).

As per claim 14 Owens et al (6,338,140 B1) teach the calling card of claim 13 where said alpha-numeric string is related to an ID that is related to the numbers in said table (see col.16, lines 36-66 where the relationship between the alpha-numeric string number in line 60 is related to the random PIN related to the specific number).

15.   **Claims 15-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Owens et al (6,338,140 B1) in view of AAPA; and further view of Walker et al (6,325,284

B1).

16.   **As per claims 15-17** Owen teach all limitations of the claim but do not disclose

having a transparent collimating layer on said card, magnifying and narrowing field view.

However Walker et al (6,325,284 B1) teach transparent collimating layer on said card,

magnifying and narrowing field view (see fig.2, 6, 8 and 10 where the card has a LCD

that based on the time set magnify a message based on the ambient light and after time

is expired it is narrowed to a point that is not being able to be read. It would have been

obvious to one of ordinary skilled in the art to utilize mark's message projection on the

card's LCD in Owen's method and system in view if AAPA in order to generate power to

the card when there is an activity with respect to display of a message or identification

code.

Conclusion

17.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

        U.S.Patent No. US (6,466,671 B1) teach smartcard for use with a receiver of

        encrypted broadcast signal, and receiver.

U.S.Patent No. US (6,356,935 B1) teach apparatus and method for an

authenticated electronic userid.

U.S.Patent No. US (6,011,847 A) teach cryptographic access and labeling

system.

U.S.Patent No. US (5,870,723 A) teach tokenless biometric transaction

authorization method and system.

U.S.Patent No. US (5,825,871 A) teach information storage device for storing
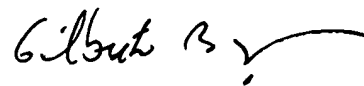
personal identification information.

U.S.Patent No. US (5,818,930 A) teach auto-dialer housing.

U.S.Patent No. US (5,613,012 A) teach tokenless identification system for

authorization of electronic transactions and electronic transmissions.

18.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kambiz Zand whose telephone number is (703) 306-

4169. The examiner can normally reached on Monday-Thursday (8:00-5:00). If attempts

to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Gilberto Barron can be reached on (703) 305-1830. The fax phone numbers for the

organization where this application or proceeding is assigned are as follows:

Official   (703) 872-9306

Kambiz Zand
11/15/2003

GILBERTO BARRON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100